Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RUSSELL W. KOCH

Appeal No. 1999-2492
Application No. 08/801,676

ON BRIEF

Before,GARRIS, KRATZ and JEFFREY T. SMITH, Administrative Patent Judges.

KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 1-5 and 10-15, which are all of the claims pending in this application.

BACKGROUND

Appellant's invention relates to an adhesive laminate containing a rubber priming layer, an adhesive layer and a metal priming layer. Moreover, appellant is concerned with a rubber vehicle air spring bonded to a support sleeve with the adhesive laminate. An understanding of the invention can be

derived from a reading of exemplary claim 10, which is reproduced below.

> 10. An adhesive laminate for adhering a rubber to a metal, comprising;
>
> a reacted rubber primer layer, a metal primer layer, and a cured adhesive layer located between said rubber primer layer and said metal primer layer, wherein said rubber primer is a halogen donating compound, or a trichlorotriazinetrione, or a N-halonydantoin, or a N-haloamide, or a N-haloimide, or an acetamide, or combinations thereof; wherein said metal primer is a mixture comprising a chlorosulfonated polyethylene, a chlorinated paraffin, and a polydinitrosobenzene; or an aqueous composition comprising a polyvinyl alcohol stabilized aqeous phenolic resin dispersion; and wherein said adhesive is an epoxy based resin, or a polyurethane adhesive, or a polymer containing an acid halide group or a haloformate group, or a polymer containing an anhydirde group which upon reaction with a diamine yields and amine-acid linkage.

In addition to alleged admitted prior art, the following prior art references of record are relied upon by the examiner in rejecting the appealed claims:

Geyer et al. (Geyer)	2,226,605	Dec. 31, 1940
Ruggeri et al. (Ruggeri)	2,711,383	Jun. 21, 1955
Schubert et al. (Schubert)	4,029,305	Jun. 14, 1977
White et al. (White)	4,327,150	Apr. 27, 1982
Iwasa et al. (Iwasa)	4,755,548	Jul. 05, 1988

Societe Europeenne De Propulsion (FR 2,303,843[1]), French Published Patent Application No. 2,303,843, Oct. 08, 1976.

Claims 1-5, 14 and 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Schubert in view of FR 2,303,843, either of White or Iwasa, and alleged admitted prior art.[2] Claims 1-5, 14 and 15 also stand rejected under 35 U.S.C. § 103 as being unpatentable over Geyer in view of Ruggeri, further in view of FR 2,303,843, either of White or Iwasa, and the alleged admitted prior art. Claims 10-13 stand rejected under 35 U.S.C. § 103 as being unpatentable over FR 2,303,843 in view of White or Iwasa, and the alleged admitted prior art.

We refer to appellant's brief and reply brief and to the examiner's answer for an exposition of the respective

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[1] All references to FR 2,376,666 in this decision are to the English language translation of record.

[2] While the source of the alleged prior art admission is not repeated in the answer, the examiner refers to appellant's specification at page 4, line 15 through page 5, line 36, page 6, line 4 through page 7, line 5 and page 9, line 33 through page 12, line 11 at page 3 of the final rejection mailed June 22, 1998 as representing admitted prior art.

viewpoints expressed by appellant and the examiner concerning the rejections.

OPINION

Upon careful review of the record, we find ourselves in agreement with appellant that the examiner has failed to carry the burden of establishing a prima facie case of obviousness. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1471-1472, 223 USPQ 785, 787-788 (Fed. Cir. 1984). Accordingly, we will not sustain the examiner's rejections, as stated.

The obviousness, within the meaning of 35 U.S.C. § 103, of combining the teachings of FR 2,303,843 with White or Iwasa, and the alleged admitted prior art in a manner to arrive at appellant's adhesive laminate as recited in claim 10 or so as to arrive at the adhesive laminate component of appellant's claim 1 is central to each of the examiner's rejections. Concerning this matter, in describing FR 2,303,843 in the carryover paragraph at pages 4 and 5 of the answer and in the rejections, the examiner makes clear that FR 2,303,843 does not teach the metal primer component or the specific rubber primer of appellant's adhesive laminate.

Rather FR 2,303,843 describes a rubber/metal bonding system that includes an adhesive layer that may correspond to appellant's adhesive layer and a rubber primer, which rubber primer the examiner has not clearly established as corresponding with appellant's specifically claimed rubber primer layer.

To make up for those deficiencies of FR 2,303,843, the examiner relies on White or Iwasa, and the alleged admitted prior art. However, the examiner has not identified a particularized suggestion, reason or motivation to combine the applied references or make the proposed modification of FR 2,303,843 in a manner so as to arrive at the claimed invention as is required for a sustainable rejection. See In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998). Rather, the examiner merely offers conclusory remarks and makes generalized statements regarding the applied references and the proposed combination thereof in the answer. The other references applied by the examiner in rejecting claims 1-5 and 14 and 15 do not remedy the above-noted shortcomings. Thus, even if we could agree that the examiner has established the referred to portions of the specification

represent admitted prior art,[3] the stated rejections fall short of establishing the obviousness of the claimed subject matter.

For the foregoing reasons, we will not sustain any of the examiner's § 103 rejections.

CONCLUSION

The decision of the examiner to reject claims 1-5, 14 and 15 under 35 U.S.C. § 103 as being unpatentable over Schubert in view of FR 2,303,843, either of White or Iwasa, and alleged

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[3] Where the specification clearly designates something as prior art, it is permissible to use that information in the determination of obviousness. See In re Nomiya, 509 F.2d 566, 571-72, 184 USPQ 607, 612 (CCPA 1975). However, a case of obvious can not be made on the basis of appellant's own statements; that is, we must view the prior art without reading into that art appellant's teachings. See In re Sponnoble, 405 F.2d 578, 585, 160 USPQ 237, 243 (CCPA 1969). Only what the specification clearly and unambiguously identifies as prior art can be used as evidence of obviousness against the claims. Moreover, not all prior knowledge, written descriptions or prior uses constitute prior art within the meaning of 35 U.S.C. § 103.

Since we find that the examiner has not furnished an adequate basis for combining the relied upon teachings of the references to arrive at appellant's invention, we need not decide whether the examiner has met the burden of establishing that any or all of the specification passages relied upon constitute an admission of prior art, especially in the face of appellant's implied challenge set forth in the brief (page 6).

admitted prior art, to reject claims 1-5, 14 and 15 under 35 U.S.C. § 103 as being unpatentable over Geyer in view of Ruggeri, further in view of FR 2,303,843, either of White or Iwasa, and the alleged admitted prior art, and to reject claims 10-13 under 35 U.S.C. § 103 as being unpatentable over FR 2,303,843 in view of White or Iwasa, and the alleged admitted prior art is reversed.

REVERSED

BRADLEY R. GARRIS Administrative Patent Judge	)
PETER F. KRATZ Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
JEFFREY T. SMITH Administrative Patent Judge	)

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APPEAL NO. - JUDGE KRATZ
APPLICATION NO.

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DECISION: **ED**

Prepared By:

DRAFT TYPED: 08 Oct 02

FINAL TYPED: